

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS D. PETITE

Appeal No. 2000-1740
Application 08/910,980

ON BRIEF

Before BARRETT, FLEMING, and LEVY, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

Application for patent filed August 7, 1997, entitled "Transmitter for Automatically Communicating Information to a Communication Device," which is a continuation-in-part of Application 08/895,720 ('720 application), filed July 17, 1997, now U.S. Patent 5,926,531, issued July 20, 1999, which is a continuation-in-part of Application 08/825,576, filed March 31, 1997, which claims the benefit of Provisional Application 60/040,316, filed February 14, 1997. It is noted that the PALM system does not indicate this application is a continuation-in-part of the '720 application, probably because the declaration does not mention the application by number. Appellant may wish to correct this continuity information for the record.

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

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This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-16.

We affirm.

RELATED APPEALS

A decision was entered March 21, 2002, in Appeal No. 2000-0831, in Application 08/825,576. Application 09/093,160, which is a continuation-in-part of Application 08/825,576, is presently on appeal in Appeal No. 2001-1940.

BACKGROUND

The disclosed invention relates to a system for wireless transmission of user identification information from a remote access device to a communication device.

Claim 1 is reproduced below.

1. A system for transmitting billing information to a communication device, comprising:

receiving means operatively associated with the communication device for receiving data transmitted via a [sic] electromagnetic waves; and

a remote access unit having a memory configured to store user identification data and a low-power transmitter adapted to transmit the user identification data to the receiving means via electromagnetic waves, the remote access unit further having a manually-operated transmit button and a controller, responsive to the transmit button, to controllably retrieve user identification data from the memory and transmit the user identification data from the low-power transmitter.

The Examiner relies on the following reference:

Gutman et al. (Gutman) 5,221,838 June 22, 1993

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Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 1-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gutman.

We refer to the final rejection (Paper No. 7) (pages referred to as "FR__") and the examiner's answer (Paper No. 12) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the appeal brief (Paper No. 11) (pages referred to as "Br__") and reply brief (Paper No. 13) (pages referred to as "RBr__") for appellant's arguments thereagainst.

OPINION

Obviousness

Group I: Claims 1-8

Gutman discloses a battery operated electronic wallet 100 containing a receiver 200 (figure 2A) which communicates with a central financial institution computer (not shown in figure 2A). Gutman discloses (col. 8, lines 43-47): "[T]he electronic wallet 100 may be capable of transmitting a message including information relating to the balance using conventional techniques (e.g., RF communication, IR communication, and microwave communication)." The optional transmitter 220 is shown in figure 2A. Gutman disclose a communication system (e.g., paging system 300) in figure 3 in which paging receiver 200 is in wireless communication with a paging transceiver 312 which is

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connected to a paging terminal 302 which, in turn, is connected to a financial institution computer system 306 via telephone interface 304 or computer interface 310.

The rejection could have been more precisely stated, especially with respect to what constitutes the claimed "communication" device" and the "receiving means." Nevertheless, there is only a single short reference to be interpreted. With reference to figure 3, the "communication device" reads on the paging system 300 or the paging terminal 302 part of 300, the "receiving means" reads on the paging transceiver 312 or 314, the "remote access unit" reads on the receiver 200 (which is part of the electronic wallet 100), the details of which are shown in figure 2A. The "low-power transmitter" reads on the transmitter module 220 or transmitter 224 which is adapted to use RF, IF, and microwave wireless communication (col. 8, lines 43-47) (the examiner finds that "low-power" is inherent in some of these formats, EA7), the "manually-operated transmit button" reads on the keys of the input controls 209 (e.g., keyboard 102, function keys 104, and buttons 106 in figure 1), the "controller" reads on controller 205, and the "memory" reads on the memory 206 which stores financial information (col. 7, lines 47-53) which is considered to be "user identification data." Appellant does not contest the examiner's finding (FR4) that Gutman must have a "manually-operated transmit button" in order to transmit data.

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Gutman is essentially an anticipation, but the rejection is based on obviousness because of the need to discuss certain limitations, such as the "manually-operated transmit button."

Appellant argues that the "receiving means" is in means-plus-function format and must be construed to cover only the structure in the specification and equivalents thereof (Br9-10). It is argued that the "receiving means" is disclosed as an RF receiver and that Gutman has no corresponding structure since, as shown in figure 5B, the electronic wallet 510 is in communication with a financial institution 512 (Br11). The implication is that Gutman does not have "receiving means." It is further argued that Gutman fails to disclose the claimed function or the structure that performs the function (Br12-13). It is argued that the links between the electronic wallet 510 and the financial institution 512 in figure 5B would not be construed as an electromagnetic link as claimed (Br14-15).

While the rejection could have been more precisely stated, we find, with reference to figure 3, that the "receiving means" reads on the paging transceiver 312 or 314. The paging transceivers receive and transmit financial data using wireless (electromagnetic wave) communication, such as RF communication and, thus, are structures that perform the claimed function of "receiving data transmitted via a [sic] electromagnetic waves"

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and meet the means-plus-function limitation. Therefore, we find this argument unpersuasive of error.

Appellant argues that Gutman fails to disclose the claimed "communication device" and that a financial institution is not a communication device as stated by the examiner (BR14).

While the rejection could have been more precisely stated, we find, with reference to figure 3, that the "communication device" reads on the paging system 300 or the paging terminal 302 part of paging system 300. Therefore, we find this argument unpersuasive of error.

In the reply brief, appellant concentrates on the "low-power transmitter" limitation. The brief mentions this limitation as part of the disclosure of a low-power RF transmitter (e.g., Br8-9), but does not focus on the "low-power" aspect. Arguments presented for the first time in the reply brief are untimely and normally will not be considered. Cf. Kaufman Company, Inc. v. Lantech, Inc., 807 F.2d 970, 973 n.*, 1 USPQ2d 1202, 1204 n.* (Fed. Cir. 1986); McBride v. Merrell Dow and Pharmaceuticals, Inc., 800 F.2d 1208, 1210-11 (D.C. Cir. 1986) ("We generally will not entertain arguments omitted from an appellant's opening brief and raised initially in his reply brief. . . . Considering an argument advanced for the first time in a reply brief, then, is not only unfair to an appellee, . . . but also entails the risk of an improvident or ill-advised opinion on the legal issues

tendered."). Providing new arguments in the reply brief is also unfair because the examiner has no right to file a supplemental examiner's answer in response to new arguments in the reply brief. Because "low-power" was not effectively argued in the brief, there is little discussion of the limitation in the examiner's answer. The examiner only mentions that the low-power signal is inherent in Gutman's device (EA7). Appellant argues (REr3-4) that the specification discloses that "[p]referably, the transmitter 20 is an extremely low power transmitter, so that a user will have to be in close proximity (e.g., several feet) to the receiver 18 of an AFTM 10 in order to use the transmitter" (spec. at 11, lines 3-5) whereas Gutman discloses a paging transceiver in which the distance of communication is much larger than the relatively short distance traversed by appellant's "low-power transmitter."

The term "low-power transmitter" is relative. The claims do not define "low-power" by any sort of electrical power limitation or any range of transmission limitation. Range limitations from the specification will not be read into the claims. Gutman is considered to have a "low-power transmitter" because it operates off a battery 201. Moreover, cellular telephones and pagers are considered to use low power transmitters. See Sawyer et al., U.S. Patent 5,307,400, col. 1, lines 36-40 ("By dividing the radio coverage of the entire cellular system into smaller

coverage areas called cells and by using low power transmitters and coverage restricted receivers the call carrying capacity of the system is dramatically increased." (Emphasis added.)). Thus, the transmitter 324 in the paging system in figure 3 of Gutman is considered to be "low power." In addition, the alternative IR system taught by Gutman is considered "low power" in the limited range sense since IR transmission ranges are limited. For these reasons, a "low power transmitter" is taught by Gutman.

For the reasons discussed above, we conclude that appellant has failed to show error in the rejection. The rejection of claims 1-8 is sustained.

Group II: claims 9-11 and 15

Appellant argues that Gutman fails to disclose the step of "transmitting a low-power electromagnetic signal including the formatted user identification information" from a remote-access unit to a communication device (Br16).

It appears from the previous arguments that appellant is relying on "transmitting a low-power electromagnetic signal" rather than "the formatted user identification information." As discussed in connection with claim 1, the electronic wallet 100 in Gutman (corresponding to the "remote-access unit") has a receiver 200 (figures 2A & 3) with a financial message transmitter 220 (figure 2A) or 324 (figure 3) which transmits a "low power" electromagnetic signal.

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Appellant argues (Br16) that Gutman fails to disclose the step of "receiving the transmitted electromagnetic signal at the communication device."

We find that the paging transceivers 312 or 314 in figure 3 perform this step.

Appellant argues (Br16) that Gutman fails to disclose the step of "transmitting the extracted information over the telephone line for authorization."

We find that the paging terminal 302 in figure 3 performs this step using the telephone interface 304.

Appellant's arguments regarding the "low-power" limitation (RBr4) have been addressed in connection with claim 1.

For the reasons discussed above, we conclude that appellant has failed to show error in the rejection. The rejection of claims 9-11 and 15 is sustained.

Group III: claims 12 and 13

The limitations argued (at Br18) with respect to claim 12 have been previously addressed in connection with Groups I and II. The "receiver" of claim 12 performs the same function as the "receiving means" of claim 1 and is met by the paging transceiver 312 or 314 in figure 3 of Gutman. Appellant has failed to show error in the rejection. The rejection of claims 12 and 13 is sustained.

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Group IV: claim 14

The limitations argued (at Br18) with respect to claim 14 have been previously addressed in connection with Groups I and II. Appellant's arguments regarding the "low-power" limitation (RBr6) have been addressed in connection with claim 1. Appellant has failed to show error in the rejection. The rejection of claim 14 is sustained.

Group V: claim 16

Appellant assumes that the Office Action's failure to provide a substantive rejection of claim 16 was an oversight on the part of the examiner (Br20). We presume the "Office Action" refers to the final rejection. In our copy of the final rejection, the "5" in "12-15" of the obviousness rejection has been changed by hand to "6" and initialed in the margin, so claim 16 is part of the obviousness rejection. We presume the examiner would not change an action in the file after it has been mailed. However, the rejection is confused because the statement of the obviousness ground of rejection in the examiner's answer (EA4) does not include claim 16, but the response to argument section (EA8-9) does address claim 16. We assume that the examiner intends to reject claim 16.

The limitation of "a communication device disposed for communication with a financial institution via a telecommunication link" reads on the paging system 300, and "a

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receiver disposed within the communication device" reads on the paging transceiver 312 or 314 within paging system 300.

Claim 16 recites "a low-power transmitter . . . to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, without any verification of user identification data." The "low-power transmitter" limitation has been addressed in connection with the rejection of claim 1. The limitation "to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, without any verification of user identification data" is not addressed in the final rejection. For the first time, the examiner notes that track one data is typically a person's name and track two data is typically the persons account number and encoded pin number and states that "[i]t is notoriously well known in the art that, whenever, financial data of authorization data is transmitted, information such as the one claimed is transmitted" (EA9).

Appellant argues that no substantive ground of rejection of claim 16 is set forth in paragraph 10 of the examiner's answer and "[t]herefore, Appellant does not understand the purpose of the substantive comments on pages 8 and 9" (RBr7).

It is clear to us that the remarks on pages 8-9 of the examiner's answer are intended to address the patentability of claim 16. Appellant had an opportunity to respond to these

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statements in the reply brief, either on the merits or to challenge them as a new ground of rejection, but did not. Thus, we conclude that appellant has not shown error in the rejection. The rejection of claim 16 is sustained.

Definiteness

The examiner states that there is no antecedent basis for "the track one and track two data" in claim 16. Appellant argues that he sought to correct this error by deleting the term "the" in an amendment after final, which was not entered, but remains agreeable to an amendment to place the claim in condition for allowance (RBr7).

We agree that there is no antecedent basis for "the track one and track two data" and sustain the rejection. Since "track one and track two data" are defined in the specification, the indefiniteness problem would be overcome by the amendment proposed by appellant. The rejection of claim 16 is sustained.

Notation of prior art

We attach a copy of Tait et al., U.S. Patent 5,550,358, which was applied in Appeal No. 2000-0831 in Application 08/825,576, decided March 21, 2002, and which does not appear to be of record in this case. Tait is relevant to the present

claims. The contents of Tait are summarized in that opinion at pages 4-5, which we repeat below for ease of reference:

Tait discloses a remote access device (the hand-held transmitter 10 in figure 1 and corresponding transmitter 10B in the embodiment of figure 5), which accesses a financial transaction machine (receiver 12 and conventional swipe machine 30 in figures 1 and 3B). The device and system could be used for other than financial transactions (col. 7, lines 2-4). The embodiment of figure 5 has a single user-depressable button (switch 16B) and a memory configured to store user identification data (PROM 20B). Track one and track two data are described by Appellant as follows (specification, p. 16, lines 13-15): "As is known, track one data typically includes a person's name. Track two data, however, typically includes the person's account number and the encoded pin number." The term "typically" indicates that there is no fixed information. Usually, track one data represent alphanumeric data and track two data is numeric data. The PROM in Tait stores the owner's name (i.e., track one data) and the owner's personal credit number (i.e., similar to a credit card number or bank number, etc.) (i.e., track two data) (col. 4, lines 49-55). Tait discloses non-contactless transmission of credit card information that would normally be read by a card swipe machine 30 (e.g., col. 5, lines 6-8, 21-24; col. 5, line 53 to col. 6, line 4) and, thus, is presumed to transmit user identification data, including track one and track two data, normally found on a credit card. The embodiment of figure 5 does not use a PIN number, but claim 21 does not specifically require a PIN number. In any case, however, Tait further discloses storing credit information and a PIN and that the user's code (PIN) can be verified at a local location (col. 6, line 55 to col. 7, line 6), which suggests storing and transmitting credit information and a PIN number. Tait discloses a low-power transmitter. The circuit of figure 5 is configured to transmit the identification data in direct response to a manual depression of the user depressable button (switch 16B), without any verification of user identification data (the PIN comparison step is omitted, col. 6, line 50). Tait discloses that a set of buttons may be provided, with one button corresponding to each credit card (col. 5, line 53 to col. 6, line 4). Tait discloses that the receiver is connected to a central data processing and storage unit (col. 2, lines 64-67; col. 3, lines 45-52).

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Possible new ground of rejection

In any future prosecution that may take place, we recommend that the examiner consider rejecting claims 14 and 15 under 35 U.S.C. § 112, second paragraph, as indefinite. Claim 14 states that it is "[a] computer readable storage medium containing program code for controlling the operation of a system for transmitting billing information to a communication device comprising . . .," but then proceeds to define structure that is not part of the storage medium. Thus, the body and the preamble are inconsistent. Similarly, claim 15 recites "[a] computer readable storage medium containing program code for transmitting user identification information to a communication device comprising the steps of . . .," but then proceeds to define steps that are not performed by the storage medium or program code. Again, the body and the preamble are inconsistent. Since claims 14 and 15 presently stand rejected, a new ground of rejection is not necessary.

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CONCLUSION

The rejections of claims 1-16 are sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Lee E. Barnett

LEE E. BARRETT
Administrative Patent Judge

Michael R. Fleming
MICHAEL R. FLEMING

Administrative Patent Judge

Stuart A. Lums

STUART S. LEVY
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Attachment:
U.S. Patent 5,550,358

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